

REMARKS

At the time of the Office Action dated March 9, 2006, claims 1-11 were pending and rejected in this application.

CLAIMS 1-10 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 2 of the Office Action, the Examiner asserted that claims 1-10 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

With regard to claims 4-5 and 8-9, Applicants note that the Examiner has failed to establish a prima facie case of indefiniteness under 35 U.S.C. § 112. The Examiner has merely asserted that identified limitations were indefinite without establishing (a) an interpretation of the claim in light of the specification; (b) an interpretation of the claim as interpreted by one of ordinary skill in the art; and (c) that the limitation(s) in the claim does not reasonably define the invention.¹ Without the Examiner clearly defining the alleged problem and why it is a problem in connection with the issue of claim definiteness, Applicants cannot fairly evaluate the Examiner's position. Nonetheless, Applicants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claims 4-5 and 8-9, particularly when reasonably interpreted in light of the written description of the specification.²

¹ See M.P.E.P. § 2173.02.

² *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As to claims 1-2 and 6-7, the Examiner asserted that the terms "insensitive" and "sensitive" were relative. Although Applicants disagree that the Examiner's assertion that the terms "insensitive" and "sensitive" are relative, Applicants submit that the Examiner has failed to establish that one having ordinary skill would not understand the scope of the claimed invention within the meaning of the second paragraph 35 U.S.C. § 112.

Therefore, for the reasons stated above, the imposed rejection of claims 1-10 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

**CLAIMS 1, 3, 6, 8, AND 11 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON LAI ET AL., U.S. PATENT NO. 6,996,585 (HEREINAFTER LAI), IN VIEW OF
BRADSHAW ET AL., U.S. PATENT PUBLICATION NO. 2002/0129042 (HEREINAFTER BRADSHAW)**

On pages 2-7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lai in view of Bradshaw to arrive at the claimed invention. This rejection is respectfully traversed.

With regard to claim 1 the Examiner cited column 3, lines 45-47 of Lai to teach the claimed "the meaning of the data file being insensitive to the ordering of the blocks of data with the data file" and "the second checksum being insensitive to the ordering of the blocks of data with the data field." Moreover, in footnotes 1 and 2, the Examiner asserted:

Regarding the ordering of the blocks claimed, examiner interprets that since Lai's disclosure stores data records of the file, such as, filename and path; data can be located even though it is not in a specified order in the directory (Col. 3, lines 45-47, Lai). This makes Lai's procedure insensitive to the ordering of the files.

Applicants respectfully submit that the Examiner's logic is flawed. At the outset, Applicants note that the "meaning of the data file" and the "second checksum" are both being described as "insensitive to the ordering of the blocks of data with the data file." The Examiner, however, only asserts that "Lai's procedure insensitive to the ordering of the file," which does not correspond to either of the claimed limitations. Therefore, the Examiner has failed to establish that Lai discloses those limitations recited in claim 1 for which the Examiner relies upon Lai to teach.

Independent claim 6 also recites similar limitations, and Examiner has applied substantially identical arguments with regard to claim 6. Applicants, therefore, incorporate herein, as also applying to claim 6, the arguments previously presented with regard to claim 6.

The Examiner citation of Bradshaw also raises issues. On page 5 of the Office Action, the Examiner asserts in footnote 3 that "the checksum disclosed on this citation corresponds to the second checksum claimed." and in footnote 5 that "the new checksum corresponds to first checksum claimed." The "new checksum" disclosed by Bradshaw does not correspond the claimed first checksum (i.e., each of a plurality of blocks of data is provided with a first checksum). Instead, the "new checksum" is calculated "from the data contained in the node currently being processed and comparing it with the checksum read from that node." The "checksum read from that node" is the same checksum that the Examiner identified as the second checksum. Therefore, it is readily apparent that the first and second checksums identified by the Examiner in Bradshaw do not correspond to the claimed first and second checksums.

Applicants also submit that the Examiner's cited motivation to combine (i.e., paragraph [0012], lines 1-6) would not have motivated one having ordinary skill in the art to modify Lai in view of Bradshaw. The paragraph cited by the Examiner is nothing more than a statement of "need" found in the Background section of Bradshaw. The Examiner has both failed to establish that this "need" is provided by Bradshaw and that this "need" is provided by the specific features identified by the Examiner as missing in Lai. To establish a reasonable expectation of success exists of obtaining particular benefit based upon a particular modification, the Examiner must show a nexus between the proposed modification and the proposed benefit. A nexus between the benefit and modification, however, has not been established by the Examiner.

Regarding claim 6, the Examiner has failed to establish any motivation to modify Lai in view of Bradshaw to arrive at the combination limitations recited in claim 6.

Therefore, not only has the Examiner failed to establish a proper motivation to modify Lai in view of Bradshaw, even if one having ordinary skill in the art were motivated to modify Lai in view of Bradshaw in the manner suggested by the Examiner, the claimed invention would not result because the combination of Lai in view of Bradshaw fail to teach or suggest all the claimed limitations recited in independent claims 1 and 6. Thus, Applicants respectfully submit that the imposed rejection of claims 1, 3, 6, 8, 9, and 11 under 35 U.S.C. § 103 for obviousness based upon Lai in view of Bradshaw is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 2, 4, 7, AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON LAI IN VIEW OF BRADSHAW, AND FURTHER IN VIEW OF SQUIBB, U.S. PATENT NO.
5,479,654**

On pages 8 and 9 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lai in view of Bradshaw and Squibb to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 2, 4, 7, and 9 depend from independent claims 1 and 6, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 6 under 35 U.S.C. § 103 for obviousness based upon Lai in view of Bradshaw. The tertiary reference to Squibb does not cure the argued deficiencies of the combination of Lai and Bradshaw. Accordingly, the proposed combination of references would not yield the claimed invention. Moreover, as with the prior rejection, the Examiner has failed to establish a proper motivation to combine because the Examiner has failed to establish a nexus between the proposed modification and the asserted benefit associated with that modification.

Applicants, therefore, respectfully submit that the imposed rejection of claims 2, 4, 7, and 9 under 35 U.S.C. § 103 for obviousness based upon Lai in view of Bradshaw and Squibb is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 5 AND 10 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON LAI IN VIEW OF BRADSHAW, AND FURTHER IN VIEW OF KUZNETSOV, U.S. PATENT
PUBLICATION NO. 2001/0056504**

On pages 9 and 10 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lai in view of Bradshaw and Kuznetsov to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 5 and 10 respectively depend from independent claims 1 and 6, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 6 under 35 U.S.C. § 103 for obviousness based upon Lai in view of Bradshaw. The tertiary reference to Kuznetsov does not cure the argued deficiencies of the combination of Lai and Bradshaw. Accordingly, the proposed combination of references would not yield the claimed invention. Moreover, as with the prior rejection, the Examiner has failed to establish a proper motivation to combine because the Examiner has failed to establish a nexus between the proposed modification and the asserted benefit associated with that modification.

Applicants, therefore, respectfully submit that the imposed rejection of claims 1 and 5 under 35 U.S.C. § 103 for obviousness based upon Lai in view of Bradshaw and Kuznetsov is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the

prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 9, 2006

Respectfully submitted,

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